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PATENT COOPERATION TREATY

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# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

| Applicant's or agent's file reference<br>2478PTWO/er | **FOR FURTHER ACTION** | See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416) |
|---|---|---|
| International application No.<br>PCT/EP 03/03126 | International filing date *(day/month/year)*<br>26.03.2003 | Priority date *(day/month/year)*<br>28.03.2002 |
| International Patent Classification (IPC) or both national classification and IPC<br>C08G85/00, C08G85/00 | | |
| Applicant<br>N.P.T. S.R.L. et al | | |

1. This International preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 4 sheets, including this cover sheet.

   ☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

   These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

   - I ☒ Basis of the opinion
   - II ☐ Priority
   - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
   - IV ☐ Lack of unity of invention
   - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
   - VI ☐ Certain documents cited
   - VII ☐ Certain defects in the international application
   - VIII ☐ Certain observations on the international application

| Date of submission of the demand | Date of completion of this report |
|---|---|
| 27.10.2003 | 02.06.2004 |
| Name and mailing address of the international preliminary examining authority:<br>European Patent Office<br>D-80298 Munich<br>Tel. +49 89 2399 - 0 Tx: 523656 epmu d<br>Fax: +49 89 2399 - 4465 | Authorized Officer<br>Otegui Rebollo, J<br>Telephone No. +49 89 2399-8670 |

Form PCT/IPEA/409 (Cover Sheet) (January 2004)

# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/EP 03/03126

## I. Basis of the report

1. With regard to the **elements** of the international application *(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17))*:

**Description, Pages**

1-33 as originally filed

**Claims, Numbers**

1-15 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

*(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)*

6. Additional observations, if necessary:

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

| | | | |
|---|---|---|---|
| Novelty (N) | Yes: | Claims | 1-15 |
| | No: | Claims | |
| Inventive step (IS) | Yes: | Claims | |
| | No: | Claims | 1-15 |
| Industrial applicability (IA) | Yes: | Claims | 1-15 |
| | No: | Claims | |

2. Citations and explanations

**see separate sheet**

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

Reference is made to the following documents:

D1: WO-A- 98/29462
D2: EP-A-0 031 397
D3: US-A-4 231 956

The subject-matter of claims 1 to 15 of the present application is obviously derivable (Article 33(3) PCT) from the cited prior art (see passages cited in the search report) as the solution of the invention, namely the use of hydrogen sulphide in the place of the dithiols of D1 to avoid unpleasant odours in the polymers of D1 is known from D2 (see in particular the passage common to pages 5 and 6 and examples 2 and 3) so that the incorporation of this teaching in the silane-terminated polymers of D1 is a matter of routine for those skilled in the art. Furthermore, the particular basic catalysts used in the process recited in claims 14 and 15 of the application are also known (see D3). Although applicants have argued that different polymer structures and an improved weatherability of the crosslinked polymers (which as a matter of fact was not disclosed in the application) result from the substitution of hydrogen sulphide for the thiols of D1, the fact of the matter remains that there is apparently no other alternative to solve the problem underlying the application (ie the avoidance of unpleasant odours) but to replace the dithiols of D1 by hydrogen sulphide as taught by D2. In other words, the present case is a one-way street situation.